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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FORTUNET, INC.

Appeal No. 98-1501
Reexamination Control No. 90/003,991¹

HEARD: July 15, 1998

Before KRASS, JERRY SMITH, and BARRETT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

¹ Request for reexamination filed October 5, 1995, by third party requester Stuart Entertainment, Inc., for reexamination of claims 1, 2, 4-8, 10, and 13-16 of U.S. Patent 4,455,025, entitled "ELECTRONIC CARD AND BOARD GAME," issued on June 19, 1984, to Yuri Itkis, based on Application 06/301,118 ('118 application), filed September 11, 1981.

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Appellant patent owner, through new counsel, requests rehearing under 37 CFR § 1.197(b) of our decision entered September 16, 1998 (Paper No. 27).

We have reconsidered our decision in light of appellant's arguments. We withdraw the rejection of claims 17 and 18 under 35 U.S.C. § 112, first paragraph, and note several minor errors in the original decision, but otherwise decline to make any changes in our decision.

Pages of the REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.197(b) are referred to as "RR__." Pages of our original decision are referred to as "D__."

OPINION

Corrections

We note the following minor errors in our original decision:

1. On D56, line 16, "Claim 6" should be "Claim 9."
2. On D27, line 17, "claim 18" should be "claim 17."
3. On A5 and A11, right column, "Galen" should be deleted.

This

name was inadvertently left in from an earlier draft.

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Appellant's arguments

Appellant adopts a "shotgun" response, alleging every possible case law reason why a decision might be reversed without providing much in the way of analysis of the reasoning in the rejections. Appellant is precluded from presenting any new arguments for the first time in any judicial review of this decision; we are not prescient and cannot address arguments that have not been made. See In re Wiseman, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (arguments must first be presented to the Board before they can be argued on appeal).

We will follow appellant's organization of the arguments.

MODIFICATIONS REQUESTED

1. "PRINTED PUBLICATION"

Appellant argues that we improperly shifted to it the burden of proving that the 1980 CATALOG and the 1976 Agreement² are not prior art printed publications (RR1-7).

Initially, it is noted that the 1980 CATALOG and the 1976 Agreement are not critical to the obviousness rejection. We

² While appellant also argues the PLATO V TERMINAL and PLATO CURRICULAR MATERIALS references (RR4-6), only the 1980 CATALOG and the 1976 Agreement are applied in the rejection.

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anticipated that appellant might produce evidence that would prove that these references are not prior art printed publications and, therefore, we stated that our decision was not dependent on these references (D41): "While we believe that only Gluz, Taylor or Peak, and Churchill are necessary to the rejection, the 1980 CATALOG, 1976 Agreement, White, and Julien are applied as additional evidence of obviousness." Furthermore, we expressly noted at the end of the paragraph of our decision where we discussed the additional obviousness reasoning over the 1980 CATALOG and the 1976 Agreement (D47): "This reasoning based on the 1980 CATALOG and the 1976 Agreement is in addition to the reasoning over Gluz, Taylor, and Peak; thus, the rejection does not fall if either the 1980 CATALOG or the 1976 Agreement is held not to be a printed publication." Appellant proffers no evidence that the references are not prior art printed publications and, therefore, we stand by our conclusion that the 1980 CATALOG and the 1976 Agreement are prior art printed publications.

Appellant argues (RR1-7) that we erred in ignoring the statement in In re Hall, 781 F.2d 897, 899, 228 USPQ 453, 455 (Fed. Cir. 1986) that "[t]he proponent of the publication bar

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must show that prior to the critical date the reference was sufficiently accessible, at least to the public interested in the art . . ." and/or erred in interpreting the concurring opinion by Judge Plager in In re Epstein, 32 F.3d 1559, 1570-71, 31 USPQ2d 1817, 1824-5 (Fed. Cir. 1994), to shift the burden to the appellant. Appellant provides no analysis of the cases and is barred from making new arguments in any judicial review of this decision. See Wiseman, 596 F.2d at 1022, 201 USPQ at 661.

Epstein is consistent with Hall, a position apparently never considered by appellant. What is involved is the Patent and Trademark (PTO) practice referred to as the "prima facie case." Once the PTO has established a prima facie case by showing reasons why appellant is not entitled to a patent, this shifts the burden of production of evidence to the applicant to show why the PTO is wrong. "[P]reponderance of the evidence is the standard that must be met by the PTO in making rejections. . . ." In re Cavaney, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1995). In this case, the facts surrounding the documents were sufficient to establish by a preponderance (weight) of the evidence, a prima facie case

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that the references were publicly accessible prior to appellant's filing date and, therefore, were prior art printed publications. Hall requires no more. The burden of going forward with the evidence then shifted to appellant to show facts to the contrary. As discussed by Judge Plager in his concurring opinion in Epstein, it is not unreasonable to expect the applicant to bear the cost of further investigation suggested by available information once the PTO has met its initial burden of production. Therefore, we neither ignored the precedential effect of Hall nor elevated subsequent Federal Circuit opinions to be controlling over earlier Federal Circuit decisions, as we are dared to state by appellant (RR3). Appellant indicates no awareness of the concept of a prima facie case or the standard of proof. Appellant would require the PTO to prove every fact related to whether a document is a prior art printed publication by a clear and convincing standard (e.g., RBr3, 8, 12).

We have met our burden of establishing a prima facie case that 1980 CATALOG and the 1976 Agreement are prior art printed publications. The 1980 CATALOG was submitted as Exhibit A to

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the second Peltz declaration (D16). Peltz stated (page 00153):

5. Attached hereto are Exhibits "A" and "B" which are true and correct copies of certain pages of two documents I retrieved from archive files at the University of Illinois. These archive files have been used since at least the 1970's for storing catalog and other information related to the Plato System (now called NovaNet).

Thus, the document was in a computer related archive file at a state university, which reasonably suggests public accessibility to members of the university computer community. The deposition of Mr. Peltz in the file, taken in Fortunet, Inc. v. American Multi-Systems, et al., TS 92-1752-IEG(LSP) on May 27, 1993, states that what is apparently the 1980 CATALOG was retrieved from the archive at CERL (Computer Based Education Research Lab) (page 16, line 19 to page 17, line 5) and, so, provides no real additional information. Appellant could have cross-examined Mr. Peltz at the time to determine public accessibility to the archive, but did not. Appellant argues that the Peltz declaration "neglects to indicate the public accessability [sic] of these archives" (RR6), but suggests no reasons why an archive file at a state university would not be accessible to the public.

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The 1980 CATALOG has a cover with commercial quality graphics and a separate copyright page which states "Copyright © 1978, 1979, 1980 by Control Data Corporation" (page 00158) and overall appears to be the kind of document that would be publicly distributed. The cover of the catalog indicates "Control Data Education Company"; the term "Education Company" suggests a catalog intended for public distribution from a vendor of educational products to potential users. The Introduction states that "[t]his catalog describes the curriculums, courses, and learning activities that are available on the Control Data PLATO® system, unless otherwise indicated" (page 00159), which is written to a general public audience and not for some internal Control Data use. As we stated in our decision (D16): "There is no logical reason why a catalog of materials intended for use in an educational curriculum at a university would be kept confidential." These facts establish by a preponderance of the evidence that the 1980 CATALOG was publicly accessible before appellant's filing date and supports a prima facie case that the 1980 CATALOG is a prior art printed publication. There is no evidence to the

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contrary. We have only argument of counsel that: (1) a date alone is not sufficient (RR5); and (2) the Peltz declaration "neglects to indicate the public accessibility [sic] of these archives" (RR6).

The 1976 Agreement is a contract between the University of Illinois, a state university, and Control Data Corporation. There is no indication of any confidentiality agreement on the 1976 Agreement. As stated in the letter by Marcia Rotounda, Associate Counsel, University of Illinois, to Richard Prato, in-house counsel for appellant, in Exhibit 4 of appellant's list of exhibits submitted with the Brief:

Per our telephone conversation on April 14, enclosed are copies of the following publicly available University documents relating to PLATO courseware: 1) the 1976 Courseware Agreement with Control Data Corporation; and 2) the 1979 Amendment to the Courseware Agreement; and 3) a list of lessons published by CDC under those agreements as of May 7, 1986. [Emphasis added.]

In view of this statement in the record submitted by appellant, which we presume appellant has read, appellant's arguments contesting the 1976 Agreement as a prior art printed publication are frivolous. In addition, it is well known that most states have laws that provide that state contracts are public records because taxpayer funds are used to fund such

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contracts. Illinois has such a public record provision as we discovered from a two-minute search on LEXIS. As stated in Oberman v. Byrne, 445 N.E.2d 374, 379 (Ill. App. Ct. 1983):

Article VIII, section 1 of the 1970 Illinois Constitution, provides:

". . . .

(c) Reports and records of the obligation, receipt and use of public funds of the State, units of local government and school districts are public records available for inspection by the public according to law."

These facts are sufficient to establish by a preponderance of the evidence that the 1976 Agreement was a public record and, hence, to establish a prima facie case that the 1976 Agreement is a prior art printed publication.

Appellant argues that our statement that "Appellant does not deny that the 1976 Agreement is a prior art printed publication" (D32) impermissibly shifts the burden to appellant (RR6):

This attempted shift in burden is all the more improper as the reference being held to be on its face indicative of technical distribution and ready retrieval by those pursuing the associated technology is clearly part of a private contract agreement that warrants no such unfounded and speculative assumptions. In any event, the patent owner does deny any such admission and further notes that the private contractual nature of the agreement demonstrates the abusive extremes that the PTO

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would go to if it had actually been granted the authority it asserts that Judge Plager granted it.

It is apparent that appellant has made no effort at all to investigate whether or not the 1976 Agreement was publicly accessible, including reading Exhibit 4 to the list of exhibits submitted with the brief, but chooses to blindly argue that the PTO has not proven it. As discussed in the preceding paragraph, the 1976 Agreement is a public record, which establishes a prima facie case that it is a prior art printed publication sufficient to shift the burden of production of evidence to appellant. Appellant's argument that "the [1976 Agreement] being held to be on its face indicative of technical distribution and ready retrieval by those pursuing the associated technology is clearly part of a private contract agreement that warrants no such unfounded and speculative assumptions" simply characterizes the document as "clearly part of a private contract agreement" without any bona fide attempt to investigate whether it was or not. In our decision, we stated that "Appellant does not deny that the 1976 Agreement is a prior art printed publication" (D32) since appellant had submitted the 1976 Agreement. Appellant's statement that "[i]n any event, the patent owner does deny any

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such admission" (RR6) only denies any admission that the 1976 Agreement is a prior art printed publication, without addressing express statements in Exhibit 4.

The PTO has established a prima facie case that the 1980 CATALOG and the 1976 Agreement are prior art printed publications. Appellant has done nothing to show they are not except to provide attorney argument that the evidence is insufficient and that the PTO or the reexamination requester should have the burden of further investigation. This case is very similar to Epstein except that it involves the question of "printed publication" rather than "in public use or on sale." What is additionally compelling for requiring appellant to do the further investigation in this case is that appellant is or has been involved in numerous civil actions (D2-3) where presumably these documents were produced. We know the 1980 CATALOG was produced at Mr. Peltz's deposition. Appellant presumably had the opportunity at the time to cross-examine whoever produced the document and may still have the capability to force discovery. The PTO has no such discovery powers. This is not a case where burden shifting to further investigate is being abused or where appellant is being

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harassed: appellant is in the best position to discover relevant information. In view of the strict duty of disclosure requirements of 37 CFR § 1.56, we presume that appellant has conducted the necessary investigation to make sure that all relevant evidence regarding these documents has been provided to the PTO for its consideration. The record before us is sufficient to establish a prima facie case of prior art printed publication and no contrary facts have been adduced.

2. ORIGINAL PATENT CLAIM LANGUAGE

Appellant argues that we violated PTO policy in entering a new ground of rejection as to claims 17-18 under 35 U.S.C. § 112, first paragraph, based on a lack of written description in the original Itkis patent application for the limitation of "said tangible bingo card being at least partially transparent" in claim 17 because such amounts to a de facto rejection of original claim 11, which contains the limitation. Appellant argues "[t]hat this rejection of a new claim 17 because of original claim 11 language is improper and violates PTO policy is clear from MPEP § 2250 [sic, 2258] (July 1998)"

(RR7). Appellant further argues that we violated PTO policy by treating original claim limitations relative to claims 9³ and 12 (RR7-8). Appellant argues that the rejection of claims 17 and 18 and the comments regarding claims 9 and 12 should be expunged (RR8).

Whether or not a rejection follows PTO policy in the MPEP is a petitionable matter and appellant has not petitioned. The rules control over the MPEP and state that "new claims . . . will be examined . . . for compliance with the requirements of 35 U.S.C. 112," 37 CFR § 1.552(b). Thus, the rejection is considered proper. Nevertheless, rather than create a sideshow based on the MPEP, we withdraw the rejection of claims 17 and 18 under 35 U.S.C. § 112, first paragraph. We will not withdraw or expunge our comments regarding the claim problem. It is expressly permitted to note the existence of issues which cannot be raised in a reexamination "in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved." 37 CFR § 1.552(c).

³ Appellant also refers to claim 6. This is apparently due to a typographical error in our decision at D56, line 16, where "Claim 6" should have been "Claim 9."

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Therefore, appellant cannot avoid a statement on the record about the problem in claim 17 and expungement is not an appropriate action.

As to claims 9 and 12, we merely pointed out how the claims must be interpreted to be consistent with the specification so as not to raise a written description issue (D55-57). We also noted a minor lack of antecedent basis problem with claim 12. It is expressly permitted to note the existence of issues which cannot be raised in a reexamination. See 37 CFR § 1.552(c).

3. ADVISORY OPINIONS

Appellant requests "that the improper advisory opinions offered as to possible relevancy of various declarations appearing at pages 16 and 18 of the decision be expunged as being directed to matters outside the scope of any proper reexamination" (RR8). It is expressly permitted to note the existence of issues which cannot be raised in a reexamination. See 37 CFR § 1.552(c).

37 CFR § 1.196(b) NEW GROUNDS OF REJECTION

1. 35 U.S.C. § 112

The rejection under 35 U.S.C. § 112, first paragraph, has been withdrawn. Nevertheless, we do not withdraw our comments and, therefore, we will address appellant's arguments that "transparent" includes "perforations." Before doing that, we note that the examiner indicated that claim 11 contained allowable subject matter over the prior art printed publications and Gluz because "the tangible bingo cards are not disclosed as partially transparent and there is no motivation within the art to make particular cards partially transparent" (Paper No. 9, entered June 27, 1996) and appellant incorporated the limitation of claim 11 with claim 1 without further comment (Paper No. 10, Amendment received September 29, 1996). If "transparent" is interpreted to include "perforations" as argued by appellant, then claims 11 and 17 should be rejected as unpatentable because Gluz, figure 18, clearly shows cards with perforations. Appellant does not give any indication that it takes a position inconsistent with the prosecution history.

It is argued that "the support for the disputed claim language ('said tangible bingo card being at least partially

transparent') is inherent in the original disclosure of the patent under reexamination" (RR8) because the disclosure of "perforations" inherently renders that card "at least partially transparent." Appellant contends that the "observation that '[t]ransparent' does not mean 'perforated'" is in error and that the rejection lacks any reasonable basis" (RR9). Appellant argues that "the scientific definition for 'transparent' was '[p]ermitting the passage of radiation or particles" (RR10) and, since a hole permits passage of radiation, a perforation makes the card transparent.

We disagree with appellant's arguments, partly because the arguments are inconsistent with and make no attempt to explain statements in the prosecution history. "Transparent" is defined as "1a: having the property of transmitting light without appreciable scattering so that bodies lying beyond are entirely visible . . . b: so loose or open in texture as to admit the passage of light . . . c: TRANSLUCENT," Webster's Third New International Dictionary (unabridged) (G.&C. Merriam Co. 1961). "Transparent" refers to a solid or loose texture material that transmits light, such as a window or gauze. A

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"perforation" or hole does make the material it is in transparent: a wall is not transparent because it has a hole.

As noted in our decision (D57), in the amendment received January 13, 1983 (Paper No. 1½ on paper, No. 2½ on Contents page of the file wrapper), in the original '118 application for the Itkis patent, an amendment was proposed to the specification to include the statement that the game cards may use "translucent cards." This amendment was never entered, but indicates that "translucent" was intended to mean something different than perforated. There is no support for the terms "translucent" or "transparent" in the '118 application. As also noted in our decision (D56), in Paper No. 4 in the '118 application, the remarks for claim 24 (now patent claim 9) stated:

In case the card is at least partially transparent (and preferably is translucent and has imprinted Bingo numbers), the display can be visible through the card while it overlays the latter. This presents an opportunity to indicate the called Bingo numbers and the winning pattern directly utilizing the Bingo numbers imprinted on the surface of the card.

It appears that appellant was trying to add a clear, transparent (not perforated) card having numbers which overlays the display, like the translucent board in Taylor.

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Appellant does not address any of this prosecution history. Appellant's arguments that "transparent" means "perforated" are inconsistent with the use of those terms in the prosecution history.

2. 35 U.S.C. § 103

A. DUE PROCESS

Appellant argues that the rejections fail to give adequate notice of the reasons for the rejection as required by procedural due process and 35 U.S.C. § 132. Appellants argue that there is a scattered and confused presentation of possible reference combinations relied upon (RR12-13).

We stand by our rejection. It is clear that "only Gluz, Taylor or Peak, and Churchill are necessary to the rejection, [and] the 1980 CATALOG, 1976 Agreement, White, and Julien are applied as additional evidence of nonobviousness" (D41, lines 11-13). The rejection adequately informs appellant of the prior art teachings and reasons for combining the teachings.

Appellant notes that statements at A5 and A10 appear to incorrectly add a reference named "Galen" (RR11-12). We agree that the reference to Galen was inadvertently retained from an

earlier draft and should be omitted as noted in the
"Corrections" on page 2 of this decision on rehearing.

B. BROADEST REASONABLE INTERPRETATION

Appellant argues that we erred in our claim interpretation. In particular, appellant argues that a "command" indicates a predetermined type of computer operation defined by an instruction, and "data" is a general term for numbers, letters, symbols and analog quantities (RR16). It is argued that "the artisan would have understood that the 'commands and data' of Claim 1 does not encompass the mere supply of power on an appropriate line to cause a desired light to be energized as taught by both Taylor and Peak" (RR16).

Claim 1 recites "a data input means including a keyboard and a remote data entry means" in the preamble. Claim 1 recites "said data input means inputting commands and data including called bingo numbers." This does not recite whether the commands and data are inputted via the keyboard or the remote data entry means (or some other unspecified part of the data input means). Claim 1 further recites "communication

channel means operatively interconnecting remotely located means to said remote data entry means to deliver at least a portion of said commands and data from said remotely located means to said electronic game board via said remote data entry means." The phrase "at least a portion of said commands and data" (emphasis added) indicates that commands, or data, or both, can be entered via the remote data entry means; it does not require that the "at least a portion" includes a mix of both commands and data. Therefore, claim 1 requires only transmission of data, e.g., the bingo numbers, from the remotely located means to the remote data entry means. Taylor and Peak transfer called bingo numbers, which are data, from a central panel to a plurality of player boards by supplying power on an appropriate conductor. That the bingo number data is represented by a voltage on a wire does not mean there is no data as argued by appellant; it is merely a different way of transmitting the data and no particular way of transmitting data is claimed. Taylor also discloses transmitting a reset signal to end one game and begin another (col. 4, lines 28-33), which is a command. It is true that neither Taylor nor Peak discloses inputting the data and commands to a

microprocessor; the "remote data entry means" in Taylor and Peak is a set of wires into the player boards connecting wires directly to the lights. However, the obviousness rejection is based on applying the teaching of transmitting called bingo numbers to a player station in Taylor and Peak to transmitting called bingo numbers to the microprocessor controlled bingo game device of Gluz (e.g., D45, A5), which reasoning we do not find addressed anywhere in appellant's arguments. Manifestly, it would be inappropriate to argue such reasoning for the first time in any judicial review.

Appellant argues that "Claim 1 requires that the recited 'commands and data' must come from the 'remotely located means' and be the same as the 'commands and data including bingo numbers' being input by the data input means to a processing means that must determine 'status' based upon 'a mutual comparison of said called bingo numbers with said bingo card numbers and with said bingo pattern" (RR16-17). As discussed in the preceding paragraph, the phrase "at least a portion of said commands and data" (emphasis added) in claim 1 indicates that commands, or data, or both, can be entered via the remote data entry means; it does not require a mix of both

commands and data as argued by appellant. In any case, however, Taylor discloses the transmission of at least one command: the reset command.

C. UNFOUNDED SPECULATION

Appellant argues that "[t]he decision also does not explain how and why the vague phrase 'the PLATO system "calls the numbers"' from the 1980 CATALOG is interpreted to mean that some kind of data transmission is required" (RR17) and that "whatever the 1976 Agreement may teach about terminals, it teaches nothing about bingo played using such terminals" (RR17). Appellant does not point to any particular part of our decision.

The 1980 CATALOG and the 1976 Agreement are discussed in our decision at D31-33 and D46-47. The teaching of the 1980 CATALOG and the 1976 Agreement should be considered together because the 1980 CATALOG discloses a bingo game played on the PLATO system and the 1976 Agreement describes the PLATO system. The 1976 Agreement discloses the PLATO system hardware having a central computer and one or more remote terminals. In the old style terminals, without a terminal

processor for local computation, the programs were run on the central computer and data was transmitted to and from the terminals (D32-33). The 1980 CATALOG describes the bingo game as follows (D32):

This activity presents an interterminal game of Bingo that up to twenty people may play simultaneously. The PLATO system "calls the numbers" and records the top forty money winners and stores their records.

Together, these references disclose that a bingo game program is run on a central computer which is connected with up to twenty terminals. The program on the central computer "calls the numbers" and must perform the necessary steps to send and receive data and to "play" the game with individuals on the terminals because no calculation is done at the local terminals. Manifestly, this requires communication between the central computer and the terminals. Appellant does not explain what other interpretation is possible.

D. MEETING ALL CLAIM LIMITATIONS

Appellant argues that "[b]esides not addressing the 'commands and data' teachings lacking in the references in terms of the claims considered as a whole, the decision makes no attempt to show how the references teach transmission of

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any bingo related data, such as bingo cards, bingo card identification numbers, or bingo patterns to a players device" (RR17-18).

As addressed in section "B. BROADEST REASONABLE INTERPRETATION," claim 1 is met when only data (which is a "portion of said commands and data") is sent from the remotely located means to the remote data entry means. Claim 1 does not require transmission of both commands and data. Taylor and Peak disclose transmitting called bingo numbers and, in addition, Taylor discloses transmitting at least one command. As to appellant's argument that "the decision makes no attempt to show how the references teach transmission of any bingo related data, such as bingo cards, bingo card identification numbers, or bingo patterns to a players device" (RR17-18), the claims do not require transmission of the listed data. Bingo cards, bingo card identification numbers, and bingo patterns can be entered via the card reader, which is taught by Gluz. Appellant's arguments are not commensurate in scope with the claims. Cf. In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982) ("Many of appellant's arguments fail from the

outset because . . . they are not based on limitations appearing in the claims.").

Appellant argues that we improperly interpreted the "current status" as the "final status" (RR18) and did "not properly read[] 'current status' in the context of real time as used throughout the disclosure" (RR18). These arguments are based on limitations not found in the claims. We broadly interpreted "current status" to mean a current indication of "WIN" or "NO WIN" (A3). We also noted that "[t]he 'current status' is not defined to be a visual representation of a bingo card as shown in fig. 12 of Itkis" (A3). The fact that claim 3 expressly recites "indicating matches between said called bingo numbers and said bingo card numbers" indicates that such limitation is not part of claim 1, and that "current status" does not require displaying matches.

Appellant also argues (RR18):

[T]he attempted fall back position at page A3 is deficient as presenting a mere conclusion that Peak or Taylor somehow teach or suggest this Claim 1 limitation in which status is to be derived by a processing means comparison. There are no processing comparisons taught by these references because they require the player to mentally determine matches, not the player device. If the PTO is relying upon these references, or any other references for a specific teaching or suggestion, then it should be able to "indicate where such a teaching or

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suggestion appears in [these references]," as noted in
In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Gluz performs a processing means comparison between called bingo numbers and the stored bingo numbers. Gluz does not display the matches. Automatically displaying matches between the called numbers and the bingo card numbers is shown in both Taylor and Peak, although the match is a result of hardwiring between the called numbers and the bingo card number and not a processing means comparison. In Taylor, the matches are automatic because of the hardwiring. In Peak, the matches may be automatic (col. 3, line 73 to col. 4, line 3) or manual. One of ordinary skill in the art would have been taught by Taylor and Peak that matches could be automatically displayed, and this would have motivated him or her to display the matches in Gluz on, for example, Gluz's bingo screen 11. This reasoning is only necessary if the limitation of "signaling the current status of a bingo game" in claim 1 is interpreted to require displaying matches as recited in dependent claim 3.

E. CLAIM 3 LIMITATIONS

Appellant argues that "it is clear that Claim 3 requires the capability to show on a data display plural card shaped

tabloids which none of the cited references teach or suggest"
(emphasis added) (RR18-19).

Claim 3 recites that "said display[] continuously displays as many bingo shaped card shaped tabloids as there are bingo cards being played." As we noted in our decision (A6; see also D51): "Claim 3 does not require more than a single bingo card shaped tabloid." Appellant's argument does not explain how claim 3 requires more than one tabloid, if only one bingo card is being played. Claim 3 does not recite plural tabloids.

Appellant further argues (RR19):

In addition, to the lack of this kind of data display by Taylor or Peak, none of the applied references reasonably teach displaying "matches between said called bingo numbers and said bingo card numbers." Clearly, Gluz only displays bingo cards "as is." As noted above, Taylor and Peak have no true data display teachings, they only teach providing translucent bingo cards and lights to be energized, no matching of a called number to a card number is involved, at least not in the mutual comparison manner of base Claim 1.

We refer to our reasoning in the last paragraph of the preceding section. Gluz makes computer matches. Taylor and Peak display matches, albeit because of hardwiring and not a computer comparison. We conclude that the references together would have suggested displaying matches between called bingo

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numbers and bingo card numbers. The rejection is based on obviousness. Appellant fails to address what the collective teachings of the references would reasonably have suggested to one of ordinary skill in the art.

F. TEACHING AWAY

Appellant argues that the references teach away. Appellant argues that "the teaching of Gluz is that the use of a master panel-control type device is not appropriate with his device configured to play bingo" (RR20).

We agree, of course, that evidence of teaching away must be considered. See In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988) ("Evidence that supports, rather than negates, patentability must be fairly considered."). "A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). It is not a teaching away when an inventor chooses to do

something different than the prior art. Gluz recognizes that master panel-control type devices may be used, referring to Taylor and Peak. That Gluz elected not to use a master control panel to produce a portable device does not teach one skilled in the art that a master control panel will not work or teach away from using such a panel if its functions of providing central control are required.

Appellant argues (RR20):

In addition, Gluz teaches the automatic detection of bingo by the CPU 2 so as to intentionally avoid player involvement while Taylor and Peak intentionally require the player to determine bingo, complete opposite approaches that cannot be combined. Either the device is to have remote input or not and either the device determines bingo or the player does. To modify one to operate as taught by the other destroys the existing operation and a basic operating principle of these references. If in fact the numbers in Gluz were supplied remotely, the device would become a fully automated device (With [sic] regard to entry of the called bingo numbers) leaving the player with absolutely nothing to do in contradiction to the teachings of Gluz, Taylor, and Peak. Consequently, the alleged combination of teachings "would not work" compatibly with the operating principles set forth by Gluz.

We disagree with appellant's theme that there is a "teaching away" or that the combination of references would render Gluz unsuitable for its intended purpose. One of ordinary skill in the art would have had sufficient skill and knowledge to

combine desirable features of individual references (D44-45), such as the remote input of Taylor and Peak and the microprocessor control of Gluz. The fact that all features do not appear in a single reference is not a "teaching away." It is further noted that Peak expressly teaches that bingo can be determined automatically (circuit of figure 3 described at col. 5, lines 30-69) and Taylor was aware of the teachings of Peak because it is cited in the background of the invention (Taylor, col. 1, line 25). Peak also discloses that bingo can be determined by the player making the comparisons to the called numbers or by a "lazy" method where the lights of the bingo card numbers corresponding to a called number are automatically lit. One skilled in the electronic bingo art would have appreciated that any or all of these modes were possible with no one mode teaching away from another. Thus, there is nothing contradictory or destructive between the teachings of Gluz, Taylor, and Peak.

G. MODIFICATIONS DESTROYING BASIC OPERATING PRINCIPLES
AND
RENDERING UNSUITABLE FOR INTENDED PURPOSE NOT
PERMITTED

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These arguments mostly rehash the "teaching away" arguments of the previous section and we refer to our previous response.

Appellant argues (RR21-22):

The PTO also gives no consideration to the fact that Gluz was clearly fully aware of the reference teachings being relied upon from Taylor and Peak, yet found none of the PTO asserted advantages thereof to suggest that he should incorporate such teachings. To the contrary, even though well aware of these references and the relied upon teachings, Gluz determined them to be "undesirable" and expressly stated these findings.

The fact that Gluz decided not to adopt features of Taylor and Peak does not mean that Gluz or one of ordinary skill in the art would have thought those features would not work or teach away. One person's advantages are another person's disadvantages depending on what results are being sought.

"Patents are part of the literature of the art and are relevant for all they contain." In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). We consider Taylor, Peak, and Gluz for what is disclosed in relation to the claimed invention. One skilled in the art would have looked at Gluz, Taylor, and Peak and been motivated to select desirable features as taught by those patents (D44-45). The

combination does not render any of the references unsuitable for its intended purpose.

H. MOTIVATION REQUIRED

Appellant argues that "[w]hile the PTO appears to recognize the additional requirement to demonstrate motivation at the bottom of page 40 ('given the motivation to do so') it fails to even attempt to properly weigh the motivation factors present to reach a fair conclusion based upon logical reasoning apparent from positive, concrete evidence of record" (RR22-23).

The motivation is discussed throughout the rejection in our decision (D41-52). For example, see the discussion at A44-45.

I. AMBIGUOUS REFERENCE STATEMENTS

Appellant argues that "the PTO finding (at page 32) that the 1980 CATALOG discloses 'that bingo may be played on a network of terminals where the system "calls the numbers"' is nothing more than an unwarranted assumption made relative [to] what are clearly ambiguous statements in the single short

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paragraph being inappropriately interpreted" (RR23) and "[t]he biggest ambiguity of all is what the 'PLATO system' might be since this reference is silent as to its makeup" (RR23). Appellant also criticizes the 1976 Agreement as not teaching bingo (RR23-24).

These arguments rehash the arguments in section "C. UNFOUNDED SPECULATION." We refer back to our response in that section.

Appellant argues that there is no "established factual basis that permits an assumption that the PLATO system being referenced in the 1980 CATALOG is the exact same PLATO system reference in the 1976 Agreement because the same acronym is used" (RR24).

Since the 1976 Agreement is a contract between the University of Illinois and Control Data Corporation regarding a Control Data computer system known as the PLATO System, and the 1980 CATALOG is published by Control Data Corporation and "describes the curriculums, courses, and learning activities that are available now on the Control Data PLATO® system" (page 00159) and the bingo game is said to be played on the

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PLATO system, it is certain that both references describe the same system.

J. CLAIMS 10, 14, AND 15

Appellant argues that "none of these references have a teaching that would have motivated the artisan to provide a pseudo random bingo number generator with the devices instead of centrally with the remote entry device, at least if the proposed rationale offered as to Claim 1 is to have any credence" (RR24).

We do not find where appellant challenged the pseudo random number generator limitation as taught by Loyd in either the Brief or the Reply Brief. Although we entered new grounds of rejection, the only issue with respect to claims 10 and 14 is the same limitation as before of the pseudo random bingo number generator using the same reference to Loyd; thus, the ground of rejection of claims 10 and 14 is not new. Appellant could have argued this limitation during prosecution, but did not. This is the reason additional art was not cited. Appellant should be bound by the acts of its previous counsel and precluded from arguing previously uncontested limitations.

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See Link v. Wabash R.R. Co., 370 U.S. 626, 633-34 (1962)

("Petitioner voluntarily chose this attorney as his representative in the action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent. Any other notion would be wholly inconsistent with our system of representative litigation, in which each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'") (quoting Smith v. Ayer, 101 U.S. 320, 326 (1879)).

Nevertheless, we stand by the rejection over Loyd. Loyd discloses a centrally located manually operated pseudo random number generator. One of ordinary skill in the electronic game and bingo game art was not so lacking in skill as to limit Loyd to its express teachings of the location of the number generator. In our opinion, one of ordinary skill in the art would have been motivated to locate a pseudo random number generator as taught by Loyd in the Gluz device for the purpose of making a bingo device that could be played alone (D51-52).

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CONCLUSION

We have granted appellant's request for rehearing to the extent that we have withdrawn the rejection of claims 17 and 18 under 35 U.S.C. § 112, first paragraph, but otherwise deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

GRANTED-IN-PART

ERROL A. KRASS)	
Administrative	Patent Judge)
)	
)	
)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
)	
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